

REMARKS

Claims 1-9 and 15-20 are pending in this application.

In the Office Action, the Examiner indicated that reference AI, submitted on August 26, 2002, has not been considered because an English-language translation was not submitted. Applicant respectfully submits that an English-translation of reference AI was not “within the possession, custody, or control of, or is readily available to any individual designated....” (See 37 C.F.R. § 1.98(a)(3)(ii). Accordingly, applicants submitted an English Abstract of reference AI (See: Reference AQ submitted on August 26, 2002).

Rejection Under 35 U.S.C. § 112:

In the Office Action, the Examiner rejected claims 1-9 and 15-20 under 35 U.S.C. §112, second paragraph, as being indefinite.

In response Applicants respectfully submit that the demographic and clinical effectiveness and safety databases are established in step a) and further by the step recited in dependent claim 3. Accordingly, claims 1-9 and 15-20 are not indefinite. Therefore, the Examiner’s rejection should be removed.

In the Office Action, the Examiner rejected claims 1-9 and 15-20 under 35 U.S. C. §112, first paragraph, for lack of enablement for using DNA microarrays and Single Nucleotide Polymorphism (SNP), and successor technologies.

In response, Applicants respectfully submit that one skilled in the art knows how to test biological materials using human DNA microarrays and Single Nucleotide Polymorphism (SNP) and proteomic and successor technologies. Accordingly, claims 1-9 and 15-20 are enabled. Therefore, the Examiner’s rejection should be removed.

Rejection Under 35 U.S.C. § 103(a):

In the Office Action, the Examiner rejected claims 1-3, 6, 7 and 17 under 35 U.S.C. §103(a) as being unpatentable over Sythowski, et al. in view of FDA (1996).

In response, applicants respectfully submit that claims 1-3, 6, 7 and 17 are not obvious over Sythowski in view of FDA (1996).

Conclusion

Reconsideration of the present application is respectfully requested. If, upon review, the Examiner is unable to issue an immediate Notice of Allowance, the Examiner is respectfully requested to telephone Applicant's undersigned attorney in order to resolve any outstanding issues and advance the prosecution of the case.

An early and favorable action on the merits is earnestly solicited.

Respectfully Submitted,
DAVIDSON, DAVIDSON & KAPPEL, LLC

By: Clifford M. Davidson by Richard V. Zambrano
Clifford M. Davidson
Reg. No. 32,728
Reg No. 44,032

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018
(212) 736-1940